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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,600	10/12/2000	Jason E. Tripard	MI22-1550	2568

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EXAMINER	
CHOI, STEPHEN	
ART UNIT	PAPER NUMBER
3724	15

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/687,600	TRIPARD, JASON E.	
	Examiner	Art Unit	
	Stephen Choi	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-34,92,93 and 100-112* is/are pending in the application.

4a) Of the above claim(s) *23-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22,31-34,92,93 and 100-112* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 22, 31, 33, 92-93 and 100-109 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,508,154 in view of Patadia et al. (US 6,146,504). '154 discloses the invention substantially as claimed except for the upper surfaces being curved. Patadia teaches curved upper surfaces for supporting substrates. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a curved upper surface as taught by Patadia in order to prevent scratching. Furthermore, with respect to claim 101, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum to make the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. With respect to claim 105-106, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to select an optimum height of blocks, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. With respect to claims 107-108, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use screws or rivets for attaching the panel since the use of screws or rivets is old and well known in the art for attaching or securing elements together.

3. Claims 32 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 and 4, respectively of U.S. Patent No. 6,508,154 in view of Patadia et al. (US 6,146,504). '154 discloses the invention substantially as claimed except for the upper surfaces being curved. Patadia teaches curved upper surfaces for supporting substrates. It would have been obvious to one having ordinary skill in the art to provide a curved upper surface as taught by Patadia in order to prevent scratching.

4. Claim 111 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,508,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum to make the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 110 and 112 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,508,154. This is a double patenting rejection. The inventions of claims 110 and 112 are anticipated by the invention of claim 1 of '154 patent.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 107-108 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 107-108, it is not clear what structure is set forth by "the panel is secured to the separator...". It appears that the panel is part of the separator.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 110 is rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US 6,150,240).

Lee discloses all the recited elements of the invention including a panel and a plurality of blocks formed as one piece with the panel (10) and a cutting mechanism (35).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 22, 31-32, and 100-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gumbert (US 5,005,814) in view of Patadia et al. (US 6,146,504) and Applicant's Admitted Prior Art (AAPA).

Gumbert discloses the invention substantially as claimed including a panel (53), a plurality of blocks (29), and pins (5, 19) extending upwardly from beneath the panel to beyond an upper surface of the panel wherein the pins do not extend through the panel (element 5 extends in a direction upwardly from beneath the panel and do not extend through the element (53)). Gumbert fails to disclose curved upper surfaces and a

cutting mechanism. Patadia teaches curved upper surfaces (89). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the blocks of Gumbert with curved upper surfaces as taught by Patadia in order to prevent scratching of circuit board surfaces. Furthermore, AAPA teaches a supporting structure for a cutting operation using a cutting mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a supporting structure of Gumbert for a cutting operation using a cutting mechanism as taught by AAPA as an alternative means for supporting circuit boards. With respect to claim 101, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum to make the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. With respect to claim 102, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form blocks as one piece with the panel, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Such a modification could perform to support circuit boards with set pattern. With respect to claim 105-106, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an optimum height of blocks, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. With respect to claims 107-108, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to use screws or rivets for attaching the panel since the use of screws or rivets is old and well known in the art for attaching or securing elements together.

13. Claim 111 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 6,150,240).

Lee discloses the invention substantially as claimed except for aluminum. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum to make the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Response to Arguments

14. Applicant's arguments with respect to claims 22, 31-34, 92, 100-112 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mitchell.

16. This action is made non-final.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302 (703-872-9303 for after final). Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

sc
May 23, 2003

Stephen Choi
Patent Examiner